

Docket No. 08CS5966-2

Remarks

Claims 1-30 are pending in the present application. Claims 1-2, 4, 9-17, 19, and 21-30 have been canceled. Claims 9-16 and 21-30 have been cancelled without prejudice as directed to non-elected claims. Claims 3, 5-8, 18, and 20 have been amended, and the Specification has been amended to correct typographical errors. No new matter has been introduced by these amendments. New Claim 31 has been added. Claims 3, 5-8, 18, 20, and 31 remain for consideration upon entry of the present amendment. Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

Claim 3 has been rewritten in independent form and the language of claim 4 has been included. Support for the changes can be found in Claim 1 and Claim 4 of the Specification as filed.

Claims 5-6 has been rewritten to depend from Claim 3 and to correct typographical errors. The Markush language of Claims 5-6 has been rewritten.

Claim 7 has been amended to depend from Claim 3.

Claim 8 has been amended to claim the co-solvent amount in parts by weight. Support in the Specification can be found on page 3 ¶12.

Claim 18 has been rewritten in independent form and the language of Claim 19 has been included. Support can be found in Claim 17 and Claim 19 as filed.

Claims 20 has been amended to depend from Claim 18 and to correct typographical errors. The Markush language of Claim 20 has been rewritten.

New Claim 31 has been added. Support can be found in the Specification as filed on page 3, ¶12.

Docket No. 08CS5966-2

1. Restriction Requirement

The Examiner has outlined four patentably distinct groups of claims as follows:

Group I, which contains Claims 1-8, and 17-20 is drawn to an anti-fog coating and article, classified in class 428, subclass 428;

Group II, which contains Claims 9-16 is drawn to a process for forming an anti-fog film, classified in class 427, subclass 387;

Group III, which contains Claims 21-26 is drawn to a process for forming another anti-fog film, classified in class 427, subclass 387; and

Group IV, which contains claims 27-30 is drawn to an article, classified in class 428, subclass 428.

During a telephone conversation with Robert Walter on 12/13/02, Mr. Walter provisionally elected with traverse to prosecute the invention of Group I, Claims 1-8 and 17-20 drawn to an anti-fog coating and article.

The Applicant recognizes that restriction practice seeks to avoid multiple searches. However, MPEP 803 provides that if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. It is respectfully submitted that the examination of all the claims in this application will not place an undue burden on the PTO. Particularly, the Applicant would like to point out that the Examiner has classified Group I and IV in the same class and subclass and Group II and III in the same class and subclass. Applicant respectfully suggests that a search of Group I and Group IV would not require an undue burden on the part of the Examiner since the same search can be used. The same argument can be made for Group II and Group III. Accordingly, it is respectfully requested that the requirements for restriction and each species election be reconsidered and withdrawn.

Docket No. 08CS5966-2

2. Objection to the Disclosure

The Specification has been amended in response to an objection to the disclosure. Specifically, certain typographical errors have been corrected, such as the term “phophono” has been replaced with --phosphono—. The Applicant respectfully asserts that the term “amido” is clear to one of ordinary skill in the art. The skilled artisan would understand that the R²⁰ and R²¹ moieties may include amide functionality.

The Applicant has amended the Specification on page 5, ¶15, line 17 to read “a combination comprising at least one of the foregoing”. Applicant respectfully contends that the language is now clear and refers to a combination of functionalities in the list and not a combination of R²⁰ and R²¹.

3. Claim rejections under 35 U.S.C. § 112, Second Paragraph

Claims 4-6 and 19-20 are rejected under 35 U.S.C. § 112, Second Paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 4 and 19 have been canceled and their language has been added to Claims 3 and 18 respectively. The language taken from Claims 4 and 19 has been amended to correct the typographical error of “phophono” to --phosphono—. As explained above in regard to the Specification, the term “amido” is not unclear to one of ordinary skill in the art. “Amido” refers to an amide functional group.

Claim 5 has been rejected as not specifically defining or describing the additives, for containing duplicate additives, and by containing the term “the like”. Claim 5 has been amended to remove the redundancy of antistatic agents, to remove the language “the like” and to remove the improper Markush language.

The Applicant, however, respectfully disagrees that the additives of Claim 5 are indefinite because one species of additive may potentially satisfy the definition of more than one additive class in the claim. The fact that a single species may potentially satisfy one or more definitions does not render the claim indefinite. One of ordinary skill in the art would

Docket No. 08CS5966-2

understand what is meant by the general classes of additives as provided for in the claim. Accordingly, the Applicant respectfully requests reconsideration and removal of the rejection of Claim 5.

Claim 6 has been amended to remove the improper Markush language.

Claim 20 has been amended to remove the "glass or plastic" language before the word article, the improper Markush language has been removed, and the term "and the like" has been removed. The Applicant contends that the claim is not indefinite as currently amended.

4. Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1, 3-7 and 17-20 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by Anderson et al., U.S. Patent No. 5,932,405 (hereinafter "Anderson").

Anderson generally discloses a photographic element which includes a support, at least silver halide light sensitive layer superposed on the support, and an outermost protective overcoat superposed on the support. The protective overcoat includes a water dispersible siloxane-containing polyurethane.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

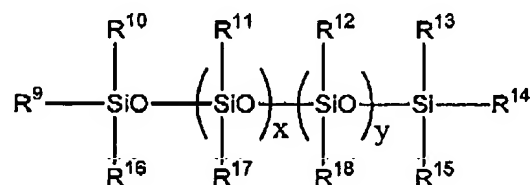
Claims 1 and 17 have been canceled. Claims 3 and 18 have been rewritten in independent format containing the language from Claims 1 and 17 respectively. The Applicant respectfully points out that Anderson fails to disclose each and every element of Independent Claims 3 and 18. Specifically, independent Claims 3 and 18, as amended, require one of two types of silicone compounds. The first type contains only hydrocarbon functionality pendant from the silicon atoms of the silicone compound. Anderson, on the other hand, teaches siloxane-containing alcohol or amine functionality, which are then reacted with isocyanates to form the polyurethane having siloxane bonds in its molecule. (See Col. 4, line 60 to Col. 5, line 32) Since the element requiring silicone compounds that

Docket No. 08CS5966-2

contain only hydrocarbon functionality is not taught by Anderson, Claims 3 and 18 are not anticipated by that reference.

Furthermore, the second type of silicone compound required by independent Claims 3 and 18, as currently amended, is also not taught by Anderson. The second type of silicone compound required by the independent claims is set forth below:

the silicone compound is an ionic or nonionic siloxane alkoylate of the formula:



wherein each of R^9 through R^{17} are independently a monovalent hydrocarbonyl radical, and R^{18} is $R^{19}-Z-(C_mH_{2m-1}R^{20}O)_j(C_nH_{2n}O)_kR^{21}$, wherein m and n are integers greater than or equal to 0; j and k are integers greater than or equal to 0, subject to the proviso that the sum of $j + k$ is greater than or equal to 1; Z is H, -O-, -S-, -SH-, -CO-, -NH-, or -NH₂-; R^{19} is a divalent hydrocarbylene radical, R^{20} and R^{21} are independently hydrogen, alkyl, hydroxyalkyl, amino, amide, amineoxide, cyano, isocyano, aryl, arylene, carboxy, alkoxy, halogen, haloalkyl, haloalkoxy, sulfo, sulfamo, phosphono, salts thereof, combinations comprising at least one of the foregoing moieties, and wherein x and y are integers greater than or equal to 0, subject to the proviso that $x + y$ is greater than or equal to 1.

Anderson teaches siloxane-containing diols or diamines of the general formula found in Column 5, wherein the hydroxy or amine functionality is pendent from the terminal siloxane group(s). As shown above, the second type of silicone compounds of Claims 3 and 18 do not contain hydroxy or amine functionality at the terminal siloxane groups of the molecule, but rather a monovalent hydrocarbonyl radical (see the groups R^9 , R^{10} , R^{13} , R^{14} , R^{16} , and R^{17} pendent from the terminal siloxane). Since the silicone compounds according to Claims 3 and 18 are not disclosed by Anderson, the claims have not been rendered anticipated.

Docket No. 08CS5966-2

Claims 5-7 and 20 ultimately depend from Claims 3 and 18. Accordingly, the Applicant respectfully requests reconsideration and removal of the 35 U.S.C. § 102(b) rejection of Claims 3, 5-7, 18, and 20.

5. Claim Rejections Under 35 U.S.C. § 103(a)

Claims 2-3, 8 and 18-19 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Anderson.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claims 2 and 19 have been canceled. The Applicant respectfully contends that Claims 3, 8, and 18 have not been rendered obvious over Anderson as Anderson fails to teach the particular silicone compounds as required in independent Claims 3 and 18. As mentioned above, Anderson fails to teach or suggest a silicone compound containing only hydrocarbon functionality or a silicone compound free of an amino or hydroxy group pendent from the terminal siloxane group(s). Since Claim 8 ultimately depends from Claim 3, it too has not been rendered obvious.

Based on the foregoing arguments, the Applicant respectfully requests reconsideration and removal of the § 103(a) rejections for Claims 3, 8 and 18.

Docket No. 08CS5966-2


It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to the Applicant. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0862 maintained by Assignee.

Respectfully submitted,

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